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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,767	11/10/2003	Ricardo Perotto	930024-2055	4372
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Ronald R. Santucci Frommer Lawrence & Haug, LLP 745 Fifth Avenue New York, NY 10151				
			EXAMINER BUTLER, PATRICK	
			ART UNIT 1732	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/705,767	Applicant(s) RICARDO PEROTTO	
	Examiner Patrick Butler	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040322</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, Claims 1-19, in the reply filed on 10 July 2006 is acknowledged.

Claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 July 2006.

Information Disclosure Statement

The information disclosure statement filed 22 March 2004 fails to comply with 37 CFR 1.98(b)(1), which requires the following: Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. Specifically, cited US Patent No. 3,548,081 issued 15 December 1970 to DeMarinis et al. It appears that the cited document is a typographical error.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With respect to Claim 9, the term "polyester felt" is used. Felt is made of wool, however a felt-like material may be made of polyester (see Smith, *Textiles in Perspective*, pages 254, 255, and 418; Collier, *Understanding Textiles*, pages 358 and 359). However, neither wool felt nor a polyester felt-like material is claimed. Therefore, it is unclear whether wool, a polyester-wool blend, or polyester is the material. For purposes of examination, the examiner interprets the phrase "polyester felt" to mean any non-woven material having some content of polyester.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b):

Claims 1-4 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,955,017.

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Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 5 of U.S. Patent No. 5,955,017 teaches the claimed process of making a connected sole and upper of a shoe (a method of manufacturing a part of a sports boot) by injection molding (in composite material) with the steps of molding a resting surface of a sole (preparing a first blank in a flexible material intended to form the external face of the boot part) and an upper (a second flexible material intended to form the internal face of the boot part) and placing the sole and upper in a mold with the sole against an impression 8 (placing the first and second blanks on the impression of a first half of a mold with the first blank against the impression), and removing from the mold after curing of the injected material (see Fig. 7-12).

Regarding Claim 1, although Claim 5 of U.S. Patent No. 5,955,017 teaches injecting into the mold, Claim 5 of U.S. Patent No. 5,955,017 does not specifically teach closing the mold, using a foamable binding material, and removing the cured product from the mold.

However, it is submitted that it for the injected material to be contained, the mold would have been at least partially closed (closing the mold by using its second half). It is also submitted that the use of polyurethane as an injection molded material is well known (injecting a foamable binding material between the blanks). It is also submitted that for use of the product and reuse of the mold, it would need to be removed (mold release after polymerization of the injected material so as to obtain the boot part).

Regarding Claim 2, Claim 5 of U.S. Patent No. 5,955,017 teaches the part made comprises the upper. Therefore it is a part of the upper of the boot.

Regarding Claim 3, although Claim 5 of U.S. Patent No. 5,955,017 teaches making the sports boot part, Claim 5 of U.S. Patent No. 5,955,017 does not specifically teach that the sole is rubber.

However, it is submitted that the use of vulcanized rubber as a sole is well known (wherein the injected material is a polyurethane foam). The rubber is vulcanized, which makes it synthetic. The sole is rubber, which is a polymer, and shaped as a film 4. Therefore, the sole is a polymer film and thus a fabric (see Smith, *Textiles in Perspective*, page 418).

Regarding Claim 4, as previously described, the sole is vulcanized rubber (elastic) and is fabric as described with respect to Claim 3.

Regarding Claim 10, although Claim 5 of U.S. Patent No. 5,955,017 teaches injecting into the mold, Claim 5 of U.S. Patent No. 5,955,017 does not specifically teach using polyurethane as the injected binding material.

However, it is submitted that the use of polyurethane as an injection molded material is well known (wherein the injected material is a polyurethane foam).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 5, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Foffano et al. (US Patent No. 5,995,017).

With respect to Claim 1, Foffano teaches a method of making a connected sole and upper of a shoe (a method of manufacturing a part of a sports boot) by injection molding (in composite material) with the steps of molding a resting surface of a sole from rubber (preparing a first blank in a flexible material intended to form the external face of the boot part) and an upper (a second flexible material intended to form the internal face of the boot part) and placing the sole and upper in a mold with the sole against an impression 8 (placing the first and second blanks on the impression of a first half of a mold with the first blank against the impression) (claims 1 and 5; col. 2, lines 64-66), closing the mold (See Fig. 3-4) (closing the mold by using its second half), injecting polyurethane between the two layers (injecting a foamable binding material between the blanks) (see col. 3, lines 32; claim 5), and removing from the mold after curing of the injected material (mold release after polymerization of the injected material so as to obtain the boot part) (see Fig. 7-12).

With respect to Claim 2, the part made comprises the upper 2, therefore it is a part of the upper of the boot (see Fig. 12; claims 1, 4, and 5).

With respect to Claim 5, the sole 4 is vulcanized rubber (an elastomer) (see col. 3, line 33).

With respect to Claim 10, Foffano teaches injecting polyurethane between the two layers (see col. 3, lines 32; claim 5).

Claims 3 and 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Foffano et al. (US Patent No. 5,995,017) as evidenced by Smith (*Textiles in Perspective*, page 418).

With respect to Claim 3, the sole 4 is vulcanized rubber (see col. 3, line 33). The rubber is vulcanized, which makes it synthetic. The sole is rubber, which is a polymer, and shaped as a film 4. Therefore, the sole is a polymer film and thus a fabric (see Smith, *Textiles in Perspective*, page 418).

With respect to Claim 4, the sole 4 is vulcanized rubber (elastic) (see col. 3, line 33) and is fabric as described with respect to Claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Sassler (US Patent No. 4,187,623).

With respect to Claim 6, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach the thickness of the rubber sole.

Sassler teaches making a sports shoe with a rubber sole (first material) with a sole thickness of at the most 1.5 to 1.8 mm (see Sassler, col. 1, lines 34-39), which

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includes the claimed range of 0.8 - 1 mm (the first material has a thickness of from 0.8 to 1 mm).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Sassler's sole thickness with Foffano's method of making a shoe in order to craft an extremely lightweight athletic shoe (see Sassler, col. 1, lines 34-39).

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Huebner et al. (German Patent Document No. DE 19512499C1).

With respect to Claims 7 and 9, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach the thickness of the rubber sole.

Huebner teaches making a shoe with the upper containing polyester felt (synthetic fabric; polyester felt) at the toe (see abstract and title).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Huebner's polyester felt upper with Foffano's method of making a shoe for the toe cap to be able to retain its air trapping quality under compression at pressures arising during normal use (see Huebner, abstract).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Legassie et al. (US Patent No. 5,343,638).

With respect to Claim 8, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that the second material comprises elastic fabric.

Legassie teaches using elastic fabric in the upper of a shoe (the second material comprises elastic fabric) (see col. 11, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Legassie's elastic fabric with Foffano's method of making a shoe in order to have an upper that is extremely lightweight and supportively conforms to the contour of the wearer's foot (see Legassie col. 11, lines 35-41).

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Brehmer et al. (US Patent No. 4,793,882).

With respect to Claims 11 and 12, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold.

Brehmer teaches screen-printing a part of a shoe upper (one of the materials has an element affixed to it before it is placed in the injection mold) (see col. 1, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine screen printing the shoe upper as taught by Brehmer

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with Foffano's method of making a shoe in order to stiffen the shoe upper (see Brehmer, col. 3, lines 12-14).

Claims 11, 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Perotto '130 (US Patent No. 4,428,130).

Foffano teaches a method of making a part of a sports boot as previously described.

With respect to Claims 11, 13, 14, and 17, Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold.

Perotto '130 teaches affixing an eyelet element to a constructed upper before the upper is assembled to form a shoe (one of the materials has an element affixed to it before it is placed in the injection mold; wherein the affixed element is an eyelet for a lace) (see Fig. 1). The eyelet allows threading by hooks or a strap 10. Thus, the eyelet is a reinforcing member in that it provides a way to reinforce the wrapping integrity (a reinforcing element).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine attaching an eyelet 11 as taught by Perotto '130 with Foffano's method of making a shoe in order to have an eyelet to thread a tightening strip 10 through for the top of the item to be tightened (see Fig. 1).

With respect to Claim 14, the eyelet 11 is a ring. The ring could be used as a receiver for a hook. Therefore, it is a ring for gripping, as not step of gripping is positively claimed.

With respect to Claim 15, Foffano does not expressly teach that one of the materials has a watertight flap affixed to it before it is placed in the injection mold.

Perotto '130 teaches a flap 20 that overlies a cutout of the upper. Compared to the cutout, the flap is watertight.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine attaching a flap as taught by Perotto '130 with Foffano's method of making a shoe in order to have a flap to seal the cutout in the upper (see Fig. 1).

Claims 11, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foffano et al. (US Patent No. 5,995,017) as applied to Claim 1 above, and further in view of Perotto '319 (US Patent No. 5,050,319).

With respect to Claims 11 and 16, Foffano teaches a method of making a part of a sports boot as previously described.

Foffano does not expressly teach that one of the materials has an element affixed to it before it is placed in the injection mold, specifically a protecting tongue.

Perotto teaches attaching a tongue to an inner lining (one of the materials has an element affixed to it before it is placed in the injection mold; wherein the affixed element is a protecting tongue) (see Claim 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Perotto '319's tongue with Foffano's method of making a shoe in order to have a tongue that spread the clamping pressure exerted by the buckles of the boot on the instep and on the anterior part of the bottom of the leg at

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least to the point that it does not exert painful pressure on the tibia (see Perotto '319 col. 1, lines 14-23 and col. 3, lines 3-17).

With respect to Claim 19, the tongue provides closure on the front of the shoe part. Thus the shoe is a compartment enclosed by the affixed element. This compartment is able to be used to contain the foot or injected personalization material such as bronze for shoe bronzing. As no step of injecting a personalization material is positively claimed and because the shoe is able to fulfill this function as previously described above, the limitations of the claim are met.


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mo.-Th. 7:30 a.m. - 5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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8/31/04